

### **REMARKS**

Upon entry of this paper, claims 32-40, 48-57, 66-69, and 74-75 will be pending in the application and are presented for consideration. Claims 1-18 were previously canceled, and claims 19-31, 41-47, 58-65, and 70-73 remain withdrawn from consideration. Applicant hereby amends claims 32, 48, and 66. Applicants submit that these claim amendments introduce no new matter to the application. Support for the claim amendments can be found, e.g., at pages 16, 24-25, 27, and 30 and Figures 8 and 9D of the application as filed, and in the previously-canceled claims.

#### **Rejection Under 35 U.S.C. § 102(e)**

The Office Action rejects claims 32-34, 40, 48-52, 55, 57, 66, 68, 69, 74 and 75 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 7, 237,554 to Conrad et al. ("Conrad"). Of these, claims 32, 48, 66, 68, and 74 are independent. In particular, the Office Action on page 3 states that Conrad discloses "at least one of the retractor (14) member and the anchor member (18) is configured to be positioned on an external surface of the soft tissue (T)."

However, Applicant respectfully submits that Conrad fails to disclose each and every element of independent claims 32, 48, 66, 68, and 74. Amended independent claims 32, 48, and 66 require that "at least one of the retractor member or the anchor member is configured to be positioned on an external surface" of the soft tissue or tongue. (Emphasis added). Independent claim 68 requires that "the retractor member is configured to be positioned on an external surface of the tongue" (emphasis added), and independent claim 74 requires that "at least one of the first end and the second end being positioned on an external surface of the soft tissue" (emphasis added).

In contrast, Applicant respectfully submits that Conrad does not teach or suggest a retractor member, anchor member, first end or second end that is positioned on an external surface of the soft tissue or tongue. Rather, Conrad describes a device that is "completely implanted within the tongue T." Col. 3, l. 13-14 and FIGS. 1-10 of Conrad. A device, such as the device described by Conrad, that is completely implanted within the tongue or soft tissue has no portion that is positioned on an external surface of the tongue or soft tissue, which is required

by Applicant's independent claims 32, 48, 66, 68, and 74. Accordingly, Applicant submits that Conrad is lacking at least this element of each of Applicant's pending independent claims.

Additionally, unlike Applicant's invention, Conrad discloses an anchor that is "secured to the jawbone." Col. 3, l. 32-33; FIGS. 1-4. A jawbone is neither soft tissue nor the tongue. Securing the anchor of Conrad inside the jawbone is not securing it on an external surface of soft tissue as claimed by Applicant. *See* FIGS. 1-4 of Conrad. As discussed above, Applicant's independent claims require a retractor member, anchor member, first end or second end that is positioned on an external surface of the soft tissue or tongue. Accordingly, Applicant submits that Conrad teaches away from positioning the device on an external surface of the tissue. An anchor member that is secured to a jawbone, as disclosed in Conrad, is not positioned in an external surface of soft tissue or tongue.

In view of the foregoing, Applicant respectfully submits that Conrad fails to teach or suggest each and every element of independent claims 32, 48, 66, 68, and 74, because Conrad fails to disclose a retractor member, anchor member, first end or second end that is positioned on an external surface of the soft tissue or tongue. For at least these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 102(e) in view of Conrad. Furthermore, Applicant respectfully submits that claims 33-34, 40, 49-52, 55, 57, 69, and 75 are also allowable as each depends from an allowable independent claim.

#### **Rejection Under 35 U.S.C. § 103(a)**

The Office Action rejects dependent claims 35, 37, 53, 56, and 67 under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Conrad." As discussed above, Conrad fails to teach or suggest each and every element of independent claims 32, 48, 66, 68, and 74. Applicant respectfully submits that claims 35, 37, 53, 56, and 67 are allowable as each depends from an allowable independent claim.

The Office Action also rejects claims dependent claims 36, 38, 39, and 54 under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Conrad" in view of U.S. Patent No. 4,254,774 to Boretos ("Boretos"). As discussed above, Conrad fails to teach or suggest each and every element of independent claims 32, 48, 66, 68, and 74. Applicant submits that Boretos does not cure the defects of Conrad.

Boretos describes the manufacture of catheters with external diameters less than 1 mm and external balloons with walls less than 0.002 inches in thickness. Applicant submits that Boretos does not cure the deficiencies of Conrad in that Boretos, either alone or in combination with Conrad, does not teach or suggest a retractor member, anchor member, first end or second end that is positioned on an external surface of the soft tissue or tongue. Applicant also respectfully submits that claims 36, 38, 39, and 54 are allowable as depending from allowable independent claims.

**Conclusion**

Applicant requests that the Examiner reconsider the application and claims in light of the foregoing amendments and remarks, and respectfully submit that the claims are in condition for allowance. The Examiner is invited to call the undersigned at (617) 526-9626 to discuss the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "G E Worth", written over a horizontal line.

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